that the election of species rules remained unchanged. Accordingly, Applicants request that the Examiner examine the non-elected species in the independent claims.

In addition, during the Examiner interview held on January 24, 2002, the Examiner asserted that the independent claims were Markush claims, not generic claims. Even assuming, *arguendo*, that the independent claims are Markush claims and not generic claims as Applicants contend, according to MPEP §803.02, the Examiner is to still compelled to consider each of the non-elected species of the Markush group in turn. Following an election of one of the species of the Markush group,

> ...the Markush -type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markus-type claim and claims to the elected species. ... On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." (MPEP §803.02).

Thus, since the Examiner has deemed the elected species to be patentable, she is required to continue to search the other non-elected species until a species is found that is anticipated or made obvious by the prior art.

In view of the above, Applicants respectfully request that the Examiner remove the finality of the Office Action, withdraw her refusal to consider the non-elected species, and examine each of the non-elected species in turn.

Rejection under 35 U.S.C. §112, second paragraph

On page 3 of the Office Action, Claim 49 has been rejected under 35 U.S.C. §112, first paragraph for lack of enablement. In particular, the Examiner asserts that the enablement of Claim 49 require the availability of the specific antibodies 12D5 because the antibodies are not

fully disclosed nor have they been shown to be publically known and freely available. As a result, the Examiner states that a deposit of plasmids containing sequences encoding these antibodies or hybridomas which produced the antibodies should have been made. Although this deposit has been made, the Examiner states that the statement of deposit at page 57 of the specification is not in compliance with 37 CFR §1.806.

In response to this rejection, Applicants have amended the specification at page 57 to include a statement that the deposit will be maintained for at least five years after the most recent request for the furnishing of a sample of the deposit received by the depository. Applicants submit that this amendment places the specification in compliance with 37 CFR §1.806 and respectfully requests that the Examiner reconsider and withdraw this rejection.

CONCLUSION

In light of the above, Applicants believe that this application is now in condition for allowance and therefore request favorable consideration.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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2-25-02
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SERIAL NO. 09/138,091

DOCKET NO.: 9491-013-27

MARKED-UP COPY OF PARAGRAPHS, AS AMENDED

Replacement for the first full paragraph, at page 57, lines 6-15:

--This deposit was made under the provisions of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure and the Regulations thereunder (Budapest Treaty). This assures maintenance of a viable culture of the deposit for at least 30 years and at least 5 years after the most recent request for the furnishing of a sample of the deposit was received by the depository from the date of deposit. The deposit will be made available by ATCC under the terms of the Budapest Treaty, and subject to an agreement between Genentech, Inc. and ATCC, which assures permanent and unrestricted availability of the progeny of the culture of the deposit to the public upon issuance of the pertinent U.S. patent or upon laying open to the public of any U.S. or foreign patent application, whichever comes first, and assures availability of the progeny to one determined by the U.S. Commissioner of Patents and Trademarks to be entitled thereto according to 35 USC §122 and the Commissioner's rules pursuant thereto (including 37 CFR §1.14 with particular reference to 886 OG 638).--